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10/526,179

07/05/2005

Sven-Erik Carlson

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EXAMINER

RODRIGUEZ, JOSEPH C

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/526,179	Applicant(s) CARLSON, SVEN-ERIK	
	Examiner JOSEPH C. RODRIGUEZ	Art Unit 3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
 4a) Of the above claim(s) 2-4,6-10 and 14-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,5 and 11-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 February 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

Claims 2-4, 6-10 and 14-27 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected claim grouping, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 3/14/08.

Information Disclosure Statement

Here, it is noted that Applicant has failed to supply any of the references listed in the International Search Report. The references cited in the Search Report have been considered to the extent available to Examiner, but will not be listed on any patent resulting from this application because they were not provided on a separate list in compliance with 37 CFR 1.98(a)(1). In order to have the references printed on such resulting patent, a separate listing, preferably on a PTO-1449 form, must be filed within the set period for reply to this Office action. See MPEP 1893.03(g).

Further, the listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "32" has been used to designate both guides and a cutting system (see e.g., para. 63-65). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The abstract of the disclosure is objected to for improper language. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

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The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Objections

The claims are objected to because of the following informalities:

Independent claims should begin with "A" or "An" and the claims depending therefrom should begin with "The".

The claims are objected to as the form of claims 5 and 11-13 is improper. Where a claim sets forth a plurality of elements or steps, as in the instant claims, each element or step should be separated by a line indentation. See MPEP 608.01(m) and 37 CFR 1.75(i).

Further, the use of references to claim numbers (see e.g., spec., para. 1, 8 and 27) to describe the subject matter within the specification is objected to as this practice may lead to an inaccurate specification when the claims have been amended or cancelled.

The disclosure is also objected to as lacking appropriate section headings as outlined in 37 CFR 1.77. See also 37 CFR 1.72-1.77; MPEP § 608.01(a).

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5 and 11-13 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 5 and 11, the language “optionally” renders the claims unclear as it is uncertain if the “optional” feature is necessary to anticipate the claimed invention.

Regarding claims 13, the language “can be” may render the claims indefinite as it is unclear whether the features subsequent to the “can be” language are a necessary part of the claimed invention. Applicant must positively recite the features of the claimed invention. Examiner thus recommends eliminating all instances of “can be” from the claim language.

Regarding claim 13, the phrase "for example" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Regarding claim 13, the phrase "and the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "and the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Regarding claim 13, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5 and 11-12 are rejected under 35 U.S.C. 102(b) as being anticipated by DeWoolfson (US 4,440,284).

DeWoolfson (Fig. 1-7) teaches an arrangement for the acceptance or return of objects including

an acceptance zone (near 15) for the intake or positioning of the object to be accepted;

a reading device (34) in order to ascertain the association of the object with a specific deposit or a lending system (col. 4);

an identification sensor (27, 28; col. 5 teaching identification unit that calculates redemption amount);

a transporting device (chute and removable support system near 16, 22; col. 4-5) which is operationally connected with the reading device such that, after the object's association has been positively ascertained, it is transported further ;

at least one blocking member (plate 16 and structure 22) through which, upon positive ascertainment by the reading device, the object is transported;

a discharge zone (near 69) for the identified or registered object is provided, in which discharge zone at least one further position sensor (82, 84) is

provided that is capable of detecting the discharge of the object to a succeeding site or ascertaining a backward movement of an object;

a further blocking member (15) the prevents backward movement of the object.

Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Rees (GB 2 102 174).

Rees (Fig.) teaches an arrangement for the acceptance or return of objects (9) including

an acceptance zone (near 2) for the intake or positioning of the object to be accepted;

a reading device (in 11 including identification sensor) in order to ascertain the association of the object with a specific deposit or a lending system (p. 1 teaching recognition-identification unit that post-identification adds number of waste token to calculate redemption amount);

a transporting device (flap 5) which is operationally connected with the reading device such that, after the object's association has been positively ascertained, it is transported further;

at least one blocking member (bottom 5; with 3 regarded as a further blocking member to prevent backward object movement) through which, upon positive ascertainment by the reading device, the object is transported.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeWoolfson in view of Ford (US 4,280,624) and Henville (US 4,128,157).

DeWoolfson as set forth above teaches all that is claimed except for expressly teaching in the discharge zone a cutting instrument that can be folded or swiveled away and that can sever removal aids. Further, under an alternate interpretation, the feature of at least one further position sensor provided in order to detect the discharge of the object to a succeeding site or to ascertain a backward movement of an object may not be regarded as taught. These features, however, are well-known in the sorting arts. For instance, Ford teaches the use of position sensors to ensure bottles are properly positioned before a sorting task can be preformed and to ensure that the bottles do not move backwards (col. 6). Henville teaches the use of a pivoting cutting instrument to prevent fraud (Fig. 7, 9; col. 1, 6). It would thus be obvious to one with ordinary skill in the art to modify the base reference with these prior art teachings to arrive at the claimed invention. The rationale for this obviousness determination can be found in the prior art itself as cited above. The rationale can also be found in the nature of the problem being solved. Here, Applicant is addressing the problem of "string" fraud

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during the return of objects. Henville teaches that the cutting instrument is a well known solution to this problem. Further, the modification to arrive at the claimed invention would merely involve the substitution/addition of well-known elements with no change in their respective functions (i.e., addition of cutter or position sensors). Moreover, the use of prior art elements according to their known functions is a predictable variation that would yield predictable results, and thus cannot be regarded as a non-obvious modification when the modification is already commonly implemented in the prior art. See MPEP 2143. Further, the prior art discussed and cited demonstrates the level of sophistication of one with ordinary skill in the art and that these modifications would be well within this skill level. Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention of DeWoolfson for the reasons set forth above.

Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rees (GB 2 102 174) in view of in view of Ford (US 4,280,624) and Henville (US 4,128,157).

Rees as set forth above teaches all that is claimed except for expressly teaching in the discharge zone a cutting instrument that can be folded or swiveled away and that can sever removal aids and at least one further position sensor provided in order to detect the discharge of the object to a succeeding site or to ascertain a backward movement of an object may not be regarded as taught. These features, however, are

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well-known in the sorting arts. For instance, Ford teaches the use of position sensors to ensure bottles are properly positioned before a sorting task can be preformed and to ensure that the bottles do not move backwards (col. 6). Henville teaches the use of a pivoting cutting instrument to prevent fraud (Fig. 7, 9; col. 1, 6). It would thus be obvious to one with ordinary skill in the art to modify the base reference with these prior art teachings to arrive at the claimed invention. The rationale for this obviousness determination can be found in the prior art itself as cited above. The rationale can also be found in the nature of the problem being solved. Here, Applicant is addressing the problem of “string” fraud during the return of objects. Henville teaches that the cutting instrument is a well known solution to this problem. Further, the modification to arrive at the claimed invention would merely involve the substitution/addition of well-known elements with no change in their respective functions (i.e., addition of cutter or position sensors). Moreover, the use of prior art elements according to their known functions is a predictable variation that would yield predictable results, and thus cannot be regarded as a non-obvious modification when the modification is already commonly implemented in the prior art. See MPEP 2143. Further, the prior art discussed and cited demonstrates the level of sophistication of one with ordinary skill in the art and that these modifications would be well within this skill level. Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention of Rees for the reasons set forth above.

Conclusion

Any references not explicitly discussed above but made of record are considered relevant to the prosecution of the instant application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Joseph C Rodriguez** whose telephone number is **571-272-6942** (M-F, 9 am – 6 pm, EST). The Supervisory Examiner is Patrick Mackey, **571-272-6916**. The **Official** fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

The examiner's **UNOFFICIAL Personal fax number** is **571-273-6942**.

Further, information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system.

Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PAIR system, see

<http://pair-direct.uspto.gov>

Should you have questions on access to the Private PMR system, contact the Electronic Business Center (EBC) at **866-217-9197** (Toll Free).

/Joseph C Rodriguez/
Primary Examiner, Art Unit 3653
Jcr

April 25, 2008